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EXAMINER

EPPERSON, JON D

ART UNIT

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1639

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Advisory Action

1. Applicants' amendments and arguments submitted 6/26/08 have been fully considered and entered into the record. Claims 39-49 and 51-64 were pending. Applicants amended claims 39, 40, 51-58, and 61-63. In addition, claim 64 was canceled. Therefore, claims 39-49 and 51-63 are currently pending and examined on the merits.

Withdrawn Rejections/Objections

2. The objection denoted "A" is withdrawn in view of Applicants' amendments to claims 39, 40, 51-58, and 61-63 removing the extra commas. The 35 U.S.C. § 112, second paragraph rejection denoted "A" is withdrawn in view of Applicants' amendments to claims 51-53, 55-57, and 61-63. The 35 U.S.C. § 112, second paragraph rejection denoted "B" is withdrawn in view of Applicants' cancellation of claim 64. The 35 U.S.C. § 112, first paragraph rejection denoted "A" is withdrawn in view of Applicants' amendments adding the nitrogen back into all the benzodiazepine formulas recited in the claims. The 35 U.S.C. § 112, first paragraph rejection denoted "B" is withdrawn in part insofar as Applicants' amendments have mooted the rejection with respect to the "p" variable. The 35 U.S.C. § 112, first paragraph rejection denoted "C" is withdrawn in view of Applicants' cancellation of claim 64.

Maintained Rejections/Objections

Claims Rejections - 35 U.S.C. 112, first paragraph

3. Claims 51-53 and 55-63 are rejected under 35 U.S.C. 112, first paragraph, as containing

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subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention. This is a new matter rejection.

A. Withdrawn.

B. Support for the $m = 1-16$ limitation in claims 51-53, 55-58, 61-63 cannot be found. The specification only provides the 1-16 range for the n and q variables (e.g., see original claim 15, “ n is from 1 to 16”). Applicants cite page 6, line 14 to page 14, line but these pages merely provide support for n/q greater than zero. Applicants further cite page 8, line 10 but this only encompasses compounds of formula VI and, in addition, likewise fails to provide support for $n = m$ or m from 1 to 16. To the contrary, the use of different variables (i.e., m and n) rather than the same variables (e.g., n and n) and the fact that the variables can be “independently” selected signifies that the same ranges were not intended. If applicant believes this rejection is in error, applicant must disclose where in the specification support for this amendment can be found in accordance with MPEP §§ 2163.06 and 714.02.

C. Withdrawn.

Response

4. Applicants’ arguments directed to the above new matter rejection were fully considered (and are incorporated in their entirety herein by reference) but were not deemed persuasive for

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reasons set forth below. Please note that the above rejection has been modified from its original version to more clearly address applicants' arguments/claims.

[1] Applicants argue, "One for ordinary skill in the art would understand that 'm' is implicitly analogous to 'n'" (e.g., see 6/26/08 response, page 26, last paragraph).

[1] The examiner respectfully disagrees. Applicants state in their specification that m and n can be "independently" varied (e.g., see specification, page 8, line 17, "n and m are independently selected"). Thus, a careful reading of the specification supports the opposite position. Further then Applicants would have used the same variable (e.g., n) for both T and T' if the same range value was intended as purported. However, this was not done. That is, the intentional use of two different variables for T and T' (i.e., n and m, respectively) signifies that different values were intended for these combinatorial units (i.e., otherwise the same variable would have been used to label both T and T').

[2] Applicants argue, "Further, on page 8 of the specification "m" and "n" are discussed together as having the same definition" (e.g., see 6/26/08 response, page 26, last paragraph)

[2] This statement appears to be in error. The cited line reads, "n and m are positive integers, or one of them may be zero." Thus, the cited line does not define each variable to have the same definition. To the contrary, the cited passage merely requires that n and m be positive integers. For example, lines 17 and 18 in the same paragraph reads, "n and m are independently selected" suggesting that n does not have to equal m. Further, the cited passage only applied to

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compounds of formula VI and thus is not commensurate in scope with the claims.

Accordingly, the New Matter rejection cited above is hereby maintained.

Allowable Subject Matter

5. Claims 39-49 and 54 are allowed. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach or fairly suggest Applicants claimed benzodiazepine rings with an attached amino acid residue at the position indicated in the formulas (i.e., attached to the “phenyl” portion of the ring systems).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, James (Doug) Schultz can be reached on (571) 272-0763. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jon D. Epperson/
Primary Examiner, AU 1639